REMARKS

Upon entry of the present Amendment, claims 1-16 will be pending, of which claims 1-3 will have been amended to clarify the claimed invention and claims 8-16 will have been newly added to afford Applicant a scope of protection to which he is entitled. Applicant respectfully submits that claims 1-16 are in condition for allowance for at least the reasons set forth below. Thus, Applicant respectfully requests that the Examiner reconsider and withdraw all outstanding objections and rejections and indicate the allowability of claims 1-16 in the next Office communication.

Applicant notes with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed on October 14, 2003 in the present application. Applicant thanks the Examiner for returning, with the outstanding Office Action, an initialed and signed copy of the Form PTO-1449 that accompanied the October 14, 2003 Information Disclosure Statement.

Applicant also notes with appreciation the Examiner's acknowledgement of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f), as well as confirmation of receipt of the certified copy of the priority document in Application No. 09/050,868 (issued as U.S. Patent No. 6,650,365).

Applicant also notes with appreciation the Examiner's acceptance of the drawings filed concurrently with the filing of this application, *i.e.*, on July 14, 2003.

In the outstanding Office Action, the Examiner objected to the title of the invention as being non-descriptive. Upon entry of this Amendment, the title will have been amended to recite "AN IMAGE CORRECTION PROCESSING DEVICE." Applicant believes that the new title overcomes the Examiner's objection. Thus, Applicant respectfully requests that the Examiner reconsider and

withdraw the objection to the title.

Further, in the outstanding Office Action, the Examiner has rejected claim 1 under 35 U.S.C. 101 in the outstanding Office Action because the claimed invention is directed to non-statutory subject matter; claims 1, 2, 4 and 5 under 35 U.S.C. 102(a) as being anticipated by SASAKI (U.S. Patent No. 6,515,698); claim 3 under 35 U.S.C. 102(b) as being anticipated by KOBAYASHI (U.S. Patent No. 5,390,028); and, claim 6 under 35 U.S.C. 103(a) as being unpatentable over KOBAYASHI in view of SASAKI. Applicant respectfully traverses each of these rejections for at least the following reasons.

In the outstanding Office Action, the Examiner rejected claim 1 under Section 101 as being directed to non-statutory subject matter. The Examiner states that "[c]laims regarding storing image signals are descriptive material per se and are not statutory because they are not capable of causing function change in the computer." (*see* page 2 of the Office Action). The Examiner follows the statement with a suggested preamble for claim 1. Applicant notes with appreciation the Examiner's suggestion. However, Applicant submits that claim 1 is statutory within the purview of 35 U.S.C. § 101, and therefore respectfully traverses this rejection.

Applicant notes that the United States Patent and Trademark Office (USPTO) issued *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, which were published in the Official Gazette on November 22, 2005. The *Guidelines* explicitly state that "[t]he burden is on the USPTO to set forth a prima facie case of unpatentability." In establishing a prima facie case of unpatentability, the *Guidelines* state that a determination must be made whether the claimed subject matter falls within an enumerated statutory category, *i.e.*, machine, manufacture,

composition of matter, or process (also *see In re Alappat,* 33 F.3d 1526, 1542 (Fed. Cir. 1994) (en banc)). Applicant submits that the Examiner has not established a *prima facie* case of unpatentability.

Applicant submits, under the USPTO's *Interim Guidelines*, once a determination is made that the claimed subject matter falls within one of the four enumerated statutory categories, a determination must then be made whether the claimed subject matter falls within a Section 101 Judicial Exception – Laws of Nature, Natural Phenomena and Abstract Ideas or a Practical Application of a Section 101 Judicial Exception. Under this second determination, a practical application of the Section 101 judicial exception can be identified in at least two ways. First, if the claimed invention "transforms" an article or physical object to a different state or thing. Second, if the claimed invention otherwise produces a useful, concrete and tangible result.

Referring to claim 1, the claimed invention is directed to an image recording medium that may be regarded as either a manufacture or composition of matter. As such, claim 1 falls within the enumerated Section 101 statutory categories.

Next, upon entry of this Amendment, claim 1 will specifically recite "[a]n image recording medium, comprising: an image recording area configured to store an image signal, the image signal being subjected to a plurality of image correction processes in a process order; and an information recording area configured to store data indicating the process order in which the image correction processes are performed." As such, the claimed subject matter of claim 1 produces a useful, concrete and tangible result, *i.e.*, it is configured to store an image signal that is subjected to a plurality of image correction processes. Furthermore, there clearly exists a transformation of matter outside of

the claimed recording medium, *e.g.*, "the image signal being subjected to a plurality of image correction processes in a process order."

Thus, since a *prima facie* case of unpatentability under Section 101 has not been established, and the claimed subject matter of claim 1 is within the purview of patentable subject matter under Section 101, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 1, for at least the reasons discussed above.

Regarding the outstanding rejections of claims 1, 2, 4 and 5 under Section 102(a) as being anticipated by SASAKI, Applicant respectfully requests reconsideration and withdrawal of these rejections for at least the following reasons.

Initially, Applicant submits that SASAKI does not teach or suggest, alone or in any proper combination, *inter alia*, "an information recording area configured to store data indicating the process order in which the image correction processes are performed," as recited in claim 1; or, "a process order determining processor configured to determine the process order; and an image signal restoring processor configured to perform a plurality of restoration processes to the corrected image signal to restore the image signal, the plurality of restoration processes being performed in a restoring order which is the reverse of the process order," as recited in claim 2. Instead, Applicant submits that SASAKI teaches writing information on various kinds of characteristics of the CCD used in the camera device in the header parts 201 to 208 of the semiconductor memory 111.

At page 3 of the outstanding Office Action, the Examiner refers to Figure 14, the header parts, and column 8, lines 36-42 of SASAKI, to show an information recording area for storing data indicating a process order in which correction processes are performed. However, an analysis of the

cited excerpts, as well as other relevant parts of SASAKI, reveals that, contrary to the Examiner's assertions, information on the various kinds of characteristics of the CCD 101 are output from the system controller 109 (shown in Fig. 12, SASAKI) and written to the semiconductor memory 111 as header parts 201 to 208 (*see, e.g.*, column 2, lines 25-29, column 7, lines 26-45 and column 8, lines 53-55). SASAKI does not teach or suggest, an information recording area configured to store data indicating the process order in which the image correction processes are performed, as recited in claim 1, or a process order determining processor configured to determine the process order, and an image signal restoring processor configured to perform a plurality of restoration processes to the corrected image signal to restore the image signal, the plurality of restoration processes being performed in a restoring order which is the reverse of the process order, as recited in claim 2.

Claims 4 and 5 depend from independent claim 2 and are patentable for at least the reasons provided above with respect to independent claim 2, as well as for additional reasons related to their own recitations.

Thus, Applicant respectfully requests reconsideration and withdrawal of the Section 102 rejections of claims 1, 2, 4 and 5, and an indication of the allowability of claims 1, 2, 4 and 5 in the next Office communication, for at least the reasons discussed above.

Regarding the rejection of claim 3 under Section 102(b) as being anticipated by KOBAYASHI, Applicant respectfully requests reconsideration and withdrawal of this rejection for at least the following reasons.

Applicant submits that KOBAYASHI does not teach or suggest, alone or in any proper combination, *inter alia*, "a process order recording processor configured to record the process order

in the recording medium; a process order reading processor configured to read the process order from the recording medium; and an image signal restoring processor configured to perform restoration processes to the corrected image signal to restore the image signal, the restoration processes being performed in a restoring order which is the reverse of the process order," as recited in claim 3.

Contradistinctively, KOBAYASHI teaches a picture signal converting apparatus that converts a picture signal obtained from a video camera into a film recording signal. During the conversion process, KOBAYASHI teaches processing input video data VD 13 (*see* Fig. 3) by multiplying the data "by characteristics that are the reverse of gamma correction characteristics applied in the video camera 21, thus forming picture data corresponding to the picture originally inputted to the video camera 21" (*see* column 6, lines 11-15). KOBAYASHI stores the reverse gamma correction characteristics in a ROM (*see* column 6, lines 10-20). However, KOBAYASHI does not teach or suggest recording a process order as recited in claim 3, much less a process order recording processor or a process order reading processor as further recited in claim 3.

Referring to pages 4 and 5 of the outstanding Office Action, the Examiner has misconstrued the KOBAYASHI patent. The Examiner equates the gamma correction process taught by KOBAYASHI at, *e.g.*, column 6, lines 4-23, which has multiple characteristics, with the plurality of image correction processes recited in claim 3, which are performed in a process order. Applicant submits that the gamma correction process in KOBAYASHI is a single process performed by multiplying multiple characteristics; whereas, the claimed invention of claim 3 includes a plurality of processes that are performed in a process order.

Thus, Applicant respectfully requests reconsideration and withdrawal of the Section 102

rejections of claim 3, and an indication of the allowability of claim 3 in the next Office communication, for at least the reasons discussed above.

Regarding the Section 103(a) rejection of claim 6 as being unpatentable over KOBAYASHI in view of SASAKI, Applicant respectfully traverses the rejection for at least the following reasons.

At page 5 of the outstanding Office Action, the Examiner concedes that KOBAYASHI "does not disclose wherein data indicating the process order is recorded in an information recording area of the recording medium, and the image signal is recorded in an image recording area of the recording medium." The Examiner introduces SASAKI to show the admitted shortcomings of KOBAYASHI. However, Applicant respectfully submits that SASAKI fails to remedy the shortcomings found in KOBAYASHI.

Initially, Applicant notes that claim 6 depends from claim 3 and is patentable over KOBAYASHI for at least the reasons provided above with respect to claim 3, in addition to the following, further reasons.

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness. It appears that the Examiner has used impermissible and improper hindsight in formulating the rejection at issue. Outside of the teachings of Applicant's above-captioned application specification, there exists no motivation for combining the KOBAYASHI with SASAKI as suggested by the examiner. Particularly, the field of endeavor for two of the two references is different, SASAKI being directed to an image recording apparatus for storing still images in a semiconductor memory and KOBAYASHI being directed to an apparatus for recording moving images on a film using an electron beam recorder (EBR). Accordingly, one of ordinary skill in the art at the time the invention

was made would not have been motivated to combine KOBAYASHI with SASAKI as suggested by the Examiner.

Further, the Examiner provides no motivation for suggestion to make the claimed combination, which must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir.). KOBAYASHI and/or SASAKI do not provide such a motivation or suggestion. Even if KOBAYASHI could be combined with SASAKI, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The relied upon references fail to suggest such a desirability. Accordingly, for this additional reason, Applicant submits that the Examiner has improperly combined KOBAYASHI with SASAKI.

Further, even if one were to attempt to combine KOBAYASHI with SASAKI (which, Applicant submits one of ordinary skill in the art would not have been motivated to do), as suggested by the Examiner, the combination would still fail to teach or suggest all of the recitations of claim 3, much less claim 6, which depends from claim 3. For example, the combination fails to provide a teaching for the recitations of, *inter alia*, "a process order recording processor configured to record the process order in the recording medium; a process order reading processor configured to read the process order from the recording medium; and an image signal restoring processor configured to perform restoration processes to the corrected image signal to restore the image signal, the restoration processes being performed in a restoring order which is the reverse of the process order," as recited in claim 3.

Thus, Applicant respectfully requests reconsideration and withdrawal of the Section 103 rejection of claim 6, and an indication of the allowability of claim 6 in the next Office communication, for at least the reasons discussed above.

Newly added claims 7-16 depend from independent claims 1-3 and are patentable for at least the reasons provided above with respect to the independent claims 1-3, as well as for additional reasons related to their own recitations.

Thus, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections, and allowance of this application to mature into U.S. patent, including claims 1-16.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that Examiner's objection to the title, and the rejections of claims 1-6 under 35 USC §§ 101, 102 and 103 in the Office Action dated January 5, 2007, should be withdrawn. The present Amendment is in proper form, and none of the references teach or suggest Applicant's claimed invention. In addition, the applied references of record have been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, Applicant requests timely allowance of the present application.

Applicant notes that this Amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejections is made by the present Amendment. Applicant further notes that all amendments to the claims should be considered to have been made for a purpose unrelated to patentability since none of the amendments made herein have been made to overcome the prior art.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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